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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1959.

No. 299

SCRIPTO, INC.,
Petitioner,

v.

FERBER CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI

To the United States Court of Appeals
for the Third Circuit.

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SUPREME COURT OF THE UNITED STATES.

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To the United States Court of Appeals for the Third Circuit.

Petitioner, Scripto, Inc., prays that the writ of certiorari issue to review the judgment herein of the United States Court of Appeals for the Third Circuit affirming, per curiam, the judgment of the United States District Court for the District of New Jersey.

OPINIONS BELOW.

The opinion of the Court of Appeals is not yet reported in the Federal Reporter, Second Series, but may be found at 121 U. S. P. Q. 339. The opinion of the District Court is reported at 163 F. Supp. 113. Both opinions are included herein as Appendix A.

JURISDICTION.

The Court of Appeals delivered its opinion and entered judgment thereon on May 13, 1959.

Jurisdiction is believed conferred on this Court to review the judgment in question by writ of certiorari by the Act of June 25, 1948, C. 646, 62 Stat. 928, 28 U. S. C. 1254.

Review by writ of certiorari is here sought because the Court of Appeals for the Third Circuit, in affirming the judgment of the District Court, rendered a decision in conflict with decisions of the Court of Appeals for the Seventh Circuit on the same matter, and has decided an important question of federal law which has not been, but should be, settled by this Court.

QUESTIONS PRESENTED.

Whether the presumption of validity which an issued patent now enjoys by virtue of Congressional act is destroyed or weakened because a prior patent, which the Trial Court may consider pertinent, was not **specifically** cited by the Patent Office against the issued patent.

Whether the decisions of the Court of Appeals for the Seventh Circuit in construing and applying the presumption of validity section of the 1952 Patent Act, rather than the within conflicting decision of the Court of Appeals for the Third Circuit, are correct.

STATUTE INVOLVED.

In 1952 Congress enacted a completely new and comprehensive Patent Act (66 Stat. 792, 35 U. S. C. 1), the presumption of validity section being here involved:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."
>
> 66 Stat. 812, 35 U. S. C. 282.

While the Courts have uniformly held through the years that an issued patent is presumed to be valid, the present Act is the very first to give such presumption statutory stature.

It is not believed that this Court has reviewed a patent case since the Patent Act of 1952 was enacted.

STATEMENT OF THE CASE.

This action was begun by petitioner, Scripto, Inc., one of the nation's oldest and largest manufacturers of writing instruments, to protect the patented mechanism and design of its most successful ball point pen against copying by the respondent, Ferber Corporation.

The pen of petitioner was developed by its vice president and engineer, Lovejoy, who had more than thirty years experience in the writing instrument field and who devoted two and one-half years to its development; his object, he testified, was to develop a ball point pen with easily replaceable ink supply, which would be attractive and distinctive in design, economical to manufacture and assemble, and which would afford simple, foolproof operation in the hands of the public (3a-16a, 75a-82a).[1]

[1] The letter "a" refers to the Appendix to Petitioner's Brief in the Court of Appeals.

When completed the pen of petitioner was protected by three patents, one covering the simple, foolproof mechanism (100a), one the distinctive design of the barrel and overall device (89a), and a third the distinctive design of the pocket clip (95a).

The pen met with immediate commercial success, became petitioner's largest selling item since its organization in 1923, and achieved in a four and half year period sales of more than 34,000,000 pens in the United States and foreign countries.

Respondent's pen was not only made up virtually identical in appearance to petitioner's, but employed the unique, simple and foolproof mechanism of petitioner's pen.

The District Court did not decide the issues of patent infringement, but held all three patents of petitioner invalid in view of four earlier mechanical and two earlier design patents, with respect to which he said (in third paragraph of opinion):

> "Surprising as it may seem, apparently not a single one of all the prior art patents set forth in Note 2 had been called to the attention of the Patent Office when it granted Lovejoy's basic mechanical patent, applied for May 25, 1953, granted on June 5, 1956. Such is also the situation as to Lovejoy's first design patent. As to its second design patent, none of this prior art seems to have been previously called to the attention of the Patent Office, save the Fehling patent. Under such circumstances, the presumption of validity of the Lovejoy patents, on which plaintiff relies, arising from their issuance, is small indeed. In truth, the fact that the Patent Office Examiner did not have all this prior art called to his attention may well have

had much to do with the issuance of the Lovejoy patents in the first place. Apparently, when passing on these Lovejoy patents basic to Scripto's claims, the Patent Office considered these applications to be somewhat of a new departure, rather than to be, as in fact they were, only slight additions to an already crowded art."

One of the four prior art mechanical patents, Bouhier (99a), a French patent, was relied on only against the Lovejoy, clip-design patent (95a) as it showed, somewhat obscurely, a mechanism release button through the clip, a feature of the Lovejoy clip design. This patent to Bouhier and patents to Morrison (91a) and Furedy (93a) were the prior art referred to as anticipating the Lovejoy design patents (89a, 95a).

Design patents necessarily address themselves to the visual sense and visual similarity is the test both of infringement and anticipation.

When respondent's expert witness, Hughes, was testifying before the trial judge in an effort to point out similarity between the Lovejoy design and prior art patents, the following transpired:

District Judge (34a):

"I can just ask you, don't you think there is quite a difference in the appearance of that figure, Furedy, which has no neck at all, protruding up through the sloping shoulder, and Lovejoy which has a neck protruding up through the sloping shoulder with a slope both on the shoulder and the top of the neck?"

to which the witness replied:

"I doubt that one could be confused very much by one or the other. I must agree with that."

and following which, the Court observed:

"They are quite different animals."

In the witness's effort to point up similarity of design between Lovejoy and the earlier patent to Morrison, he said (35a):

"Now the same can be said generally of the Morrison patent showing a fountain pen, 155,382, where the slope is down in the direction of and toward the clip, more closely perhaps to the Lovejoy patent in suit. That is the first design."

The Court at this point observed:

"But here again it is like Furedy, but not so like Lovejoy."

and the witness replied:

"Very much like Furedy but not like Lovejoy in that it doesn't have the extending—shall we call it the neck sticking out the top."

The Court, in commenting upon the attempted comparison by the defendant's expert between the design of the Lovejoy pen and the designs of the prior art, said (36a):

"I doubt very much if the person (having reference to the public) is going to pay very much attention to the point of whether the barrel is composed of two or three parts that are obvious. I think they are going to pay attention to this nice sweep of the sloping design (of Lovejoy)."

The expert, in attempting to point out that the design of the Lovejoy clip was not new with Lovejoy, referred to the French patent of Bouhier, and stated that the drawings (99a) depicted a button extending through the clip.

The Court at this point, looking at the drawings of the Bouhier patent, said (39a):

"Do you have a better picture than that?"

The witness said:

"No, your Honor."

and the Court replied:

"I will take your word for it being a button, but I wouldn't know."

When first confronted with the prior art, the District Judge was unimpressed, even pointing out as above related the aesthetic advances of Lovejoy and the dissimilarity between Lovejoy and the prior art. However, when later learning that prior art previously distinguished had not been specifically cited by the Patent Office against the Lovejoy patents when the applications upon which they issued were being processed, the District Court adopted an entirely different attitude toward the patents, concluding, as expressed in his opinion that since "the Patent Office Examiner did not have all this prior art called to his attention," the presumption of validity of the Lovejoy patents which he had previously indulged was virtually destroyed.

The Court of Appeals for the Third Circuit in affirming the District Court said, in its per curiam opinion:

"He (District Judge) did consider, and properly, the fact that a wealth of relevant prior art had not been called to the attention of the examiner which circumstances detracted materially from the importance of the presumption in these instances."

ARGUMENT.

There is no statutory or other provision for any one "calling" a prior art patent "to the attention of the Patent Office," and reference by both lower courts to such failure is dubious. The Patent Office is the custodian and the source of prior art U. S. patents; it represents the public when an inventor is seeking a patent promised by statute; its examiners search its own records and cite only the prior patents which are considered pertinent. If there is any presumption to be indulged from the failure of the Patent Office to cite a particular patent as pertinent prior art, it is that those in the Patent Office, skilled in such matters, did not regard the omitted reference as pertinent.

The Court of Appeals for the Seventh Circuit in the 1954 decision of **Artmore Co. v. Dayless Mfg. Co.**, 208 F. (2) 1, in which certiorari was denied, 347 U. S. 920, 74 S. Ct. 518, announced the rule which is followed in that Circuit (page 4):

> "While defendants at the trial introduced many prior art patents and publications in an attempt to show that the patent in suit was anticipated by the prior art, only five of such patents are relied upon in this court. However, we need mention only three, because they are asserted to be the most pertinent . . . and much stress is laid upon the fact that these three patents were not cited by the patent office . . .
>
> "Defendant's argument based upon these prior art patents, not cited in the patent office, is not convincing. It has been held, and we think with logic, that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked."

The **Patent Act of 1952**, 66 Stat. 792, 35 U. S. C. A. 1, gives the presumption statutory stature for the first time. It is therein provided:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."
>
> 66 Stat. 812, 35 U. S. C. A. 282.

The presumption is now one "which attaches by congressional fiat to a patent," **Martin v. Ford Alexander Corp.**, 160 F. Supp. 670, 676 (D. C. Cal., 1958), and is not fairly said to be lacking merely because of an **assumed** oversight on the part of the Patent Office.

In a Commentary on the New Patent Act by P. J. Federico, Examiner in Chief of the United States Patent Office, which appears in the front of the first of the three volumes of U. S. Code Annotated devoted to Patents, it is said, at the bottom of page 5:

> "The first paragraph of section 282 declares that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on the party asserting it. That a patent is presumed valid was the law prior to the new statute, but it was not expressed in the old statute. The statement of the presumption in the statute should give it greater dignity and effectiveness."

The Court of Appeals for the Seventh Circuit uniformly and consistently adheres to the principle quoted above from its opinion in **Artmore Co. v. Dayless Mfg. Co.**, supra, and which it seems is demanded by the statute. **Helms Products, Inc. v. Lake Shore Mfg. Co.**, 227 F. (2) 677, 680 (C. A. 7, 1955); **Adler Sign Letter Co. v. Wagner Sign Service**, 112 F. (2) 264 (C. A. 7, 1940), Cer. den. 311 U. S. 692, 61 S. Ct. 73, Reh'g denied, 311 U. S. 729, 61 S. Ct. 390.

The decision of the Court of Appeals for the Third Circuit, which is here complained of, is in direct conflict with the foregoing decisions of the Court of Appeals for the Seventh Circuit, and completely ignores the clean and explicit terms of the statute which would seem to forbid indulgence in the supposition that an uncited prior art patent was overlooked by the Patent Office.

CONCLUSION.

Issuance of the writ of certiorari is respectfully prayed that upon review of this case the presumption of validity section of the Patent Act may be properly construed and the conflict between decisions of the Courts of Appeals corrected.

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APPENDIX.

Opinion of May 13, 1959, of Court of Appeals, Third Circuit.

Per Curiam.

Appellant's mechanical patent, No. 2,748,748, and two design patents, Nos. 171,093 and 176,469, were held to be invalid by the district court, primarily because they are all covered by prior art. The record affords sound basis for these conclusions.

[1] The trial judge did not, as asserted by appellant, ignore the presumption of validity attaching to appellant's patents. He did consider, and properly, the fact that a wealth of relevant prior art had not been called to the attention of the examiner which circumstances detracted materially from the importance of the presumption in these instances. Dole Refrigerating Company v. Amerio Contact Plate Freezers, Inc., ... F. 2d ..., 121 USPQ 159, 160 (3 Cir. April 16, 1959); Murray Company of Texas, Inc. v. Continental Gin Co., 264 F. 2d 65, 69, 120 USPQ 416, 419-420 (5 Cir. 1959).

The judgment will be affirmed upon the opinion of Judge Hartshorne in the district court.

Opinion of District Court.

Hartshorne, District Judge.

The crux of this case in its patent aspect is whether or not the three patents owned by plaintiff, Scripto, fall within the prior art and are therefore invalid.

In its complaint Scripto relies upon three patents assigned to it by the patentee, Charles K. Lovejoy, the first

a mechanical patent, No. 2,748,748, for a retractable ball point pen, applied for May 25, 1953, issued June 5, 1956; the second a design patent on such pen, No. 171,903, applied for October 19, 1953, issued December 15, 1953; the third a similar design patent, No. 176,469, applied for February 8, 1955, issued December 27, 1955. Plaintiff claims these patents have each been infringed by defendant's sale of its "Ferber 49er" ball point pen, though insofar as the above mechanical patent is concerned plaintiff relied only upon Claim 5 of such patent.[1] Scripto accordingly asks the usual injunction against defendant Ferber, an accounting and damages. It also claims that in Ferber's sale of its above pen, defendant has been guilty of unfair trade practices and unfair competition. But these issues have been expressly reserved by the parties for later trial, pending the determination of the patent aspect of the case. Defendant Ferber denies the above allegations, and in turn

[1] Claim 5 of such patent reads as follows: "In a retractable ball pen having a barrel, a ball point and reservoir unit housed within the barrel for sliding movement therein between retracted and projected positions, a cap removably connected to said barrel, a plunger and a laterally biased latch housed within said cap for sliding movement therein, with one end of the plunger projecting out of the cap and the opposite end engaging said reservoir for effecting projection of said ball point out of the writing end of the barrel upon depressing said projecting end of said plunger, and means for biasing said plunger and ball point unit into retracted position; the improvement of said plunger being provided with an apertured and adjacent web portion for releasably engaging a portion of said laterally biased spring latch to effect an operative combination of the plunger and latch and said plunger being further provided with a recess for receiving another portion of the spring latch, said latch being carried on said plunger in nesting relationship and the plunger and latch combination being adapted for sliding movement therewith within the cap during projection and retraction, said cap containing a shoulder housing a portion that engages said laterally biased latching member upon projection of said unit and retaining it in projected position until released, and manually operable means extending through said cap and accessible exteriorly thereof for releasing said latching member to effect retraction of said unit, and said shoulder having another portion for engaging said plunger and latch combination upon retraction and stopping the movement thereof in desired retracted position."

charges plaintiff with having been guilty of unfair trade practices and unfair competition, this latter charge having been similarly reserved for further consideration.

Not only is the use of ball point pens widespread in fact among the public, but the records of the Patent Office prove that same is indeed a crowded art.[2] Rather than taking up all of this prior art in detail, it will suffice to consider here simply the two early Hoffman patents, granted in the 1880s, for a mechanical pencil, and the Gruber patent, granted in 1948, for a ball point pen, as previously noted. Surprising as it may seem, apparently not a single one of all the prior art patents set forth in Note 2 had been called to the attention of the Patent Office when it granted Lovejoy's basic mechanical patent, applied for May 25, 1953, granted on June 5, 1956. Such is also the situation as to Lovejoy's first design patent. As to its second design patent, none of this prior art seems to have been previously called to the attention of the Patent Office, save the Fehling patent. Under such circumstances, the presumption of validity of the Lovejoy patents, on which plaintiff relies, arising from their issuance, is small indeed. In truth, the fact that the Patent Office Examiner did not have all this prior art called to his attention may well have had much to do with the issuance of the Lovejoy patents in the first place. Apparently, when passing on these Lovejoy patents basic to Scripto's claims, the Patent Office considered these applications to be somewhat

[2] See Hoffman, # 270,507, Patent issued Jan. 9, 1883, for a retractable mechanical pencil; Hoffman, # 365,747, Patent issued June 28, 1887, for a retractable mechanical pencil; Gruber, # 2,449,218, Patent issued Sept. 14, 1948, for a ball point pen; Fehling, # 2,536,923, Patent issued Jan. 2, 1951, for a retractable fountain pen; Frentzel, # 2,580,753, Patent issued Jan. 1, 1952, for a ball point fountain pen; Kuhn, # 2,692,580, Patent issued Oct. 26, 1954, for a writing instrument; Averra, # 2,722,914, application filed May 22, 1953, Patent issued Nov. 8, 1955. There are in addition, certain foreign patents, which, so far as material, will be referred to later.

of a new departure, rather than to be, as in fact they were, only slight additions to an already crowded art.

An inspection of all this prior art shows that the major additions to human knowledge which were made by the invention of the ball point pen were each and all well known to the public through this prior art before Lovejoy applied for a single one of his patents. Substantially what the ball point pen adds to the fund of human knowledge consists in the use of a ball point for writing, in the use of a semifluid ink to cover this ball point, and in the ability of the ball point pen to project the ball point for writing purposes, but to retract it when not in use. Every single one of these essential characteristics of the ball point pen, as used under the Lovejoy patent by Scripto, and in fact as used by defendant, Ferber, in his "49er", is essentially the same as that shown in one or the other of the patents which comprise this prior art, and more specifically in the above Hoffman and Gruber patents. Just as does Lovejoy, this prior art calls for the use of a ball point, calls for its use with a semifluid ink, calls for the ability, on the one hand, to project the ball point under control for writing, and, on the other hand, to retract it under control when not in use.

Nor is there any substantial difference in principle in the spring which maintains the ball point in the retracted position in these pens, or in the use of a plunger sliding *inside of the barrel of the pen, and in the spring latch* biased outwardly for control purposes lying within that plunger. As does Lovejoy, and indeed Ferber, these prior art patents disclose a barrel which is shorter in its longitudinal extent than the slidable writing unit, together with its cap, that is held in the barrel, and is adapted to slide in and out through the barrel. All of these writing units are moved longitudinally in the barrel by means of a spring which tends to retract the ball point into the surrounding

or protecting barrel when the pen is not in use. Similarly it is true of these patents generally, that there is a means toward the top of the barrel, sometimes in the form of an annular shoulder, sometimes in the form of a pin and slot, or the like, to limit the retracting motion caused by this retraction spring. Further, all these patents reveal that the plunger has associated with it some form of a latch which is biased laterally along the inside of the barrel. This latch is so biased that when it encounters a suitable latching means, such as a hole or window in the wall of the barrel, it will pop into this window, and latch the unit in a projected position when it is being used for writing. Again these prior patents, as does Scripto and Ferber, reveal some means by which this latch can be released from the above window, whether it be by manual pushing on the extension of the latch spring itself, or by a small button which comes into contact with it, to allow retraction of the writing unit. The retraction is accomplished by the natural tendency of the compression spring to expand in the absence of any counter force, such as is exerted when the latch catches in the window.

Regardless of the rest of such prior art, the two Hoffman patents show these general principles as applied to a mechanical pencil, while the Gruber patent shows them as applied to a ball point pen, Scripto's product. The early Hoffman patent makes use of annular shoulders to limit retraction in the same fashion as does Lovejoy. Similarly, *Gruber makes the same use of such annular shoulders*; as, for that matter, does Ferber. But both Gruber and Hoffman, and Ferber as well, make use of a window or hole in the barrel, in order to catch the spring latch and so hold the writing unit in projected position. Lovejoy uses its annular shoulder (whether it be continuous or interrupted is immaterial) both to act as such a "stop" in the retracted position of the writing unit, in which case a shoulder in the plunger makes contact with it, and also to maintain

the writing unit in projected position, in which case the spring latch makes contact with it. But this minor difference between Lovejoy and the prior art demonstrates no inventiveness, since it simply uses the well-known annular shoulder device for two services instead of one, i. e., it is a mere mechanical variation.

The only really substantial difference between Scripto [Lovejoy] and the prior art, on the one hand, insofar as alleged invention is concerned, or between Scripto and Ferber, on the other hand, insofar as infringement is concerned, lies in the detail of the method of control of the ball point, as it exists in the projected or writing position and in the retracted position. Further, this detail itself involves the use of means well known to every mechanic. Specifically, the above difference in control is as follows:[3]

(1) In the retracted position (a) in the prior art the control is exerted by a shoulder on the plunger, which engages an opposite shoulder formed on the inside of the barrel, (b) in Scripto [Lovejoy] the method is the same, (c) in Ferber the spring latch engages a shoulder on the inside of the barrel.

(2) In the projected or writing position (a) in the prior art the spring latch catches in a hole in the barrel, (b) in Scripto [Lovejoy] the spring latch catches on a shoulder on the inside of the barrel, (c) in Ferber the spring latch catches in the same way as in the prior art.

But whether this control occurs because of the impact of two shoulders, or because of the spring latch engaging a shoulder, or because of a spring latch catching in a hole in the barrel, is a matter of mere mechanical details, the principles of each of which, in fact, were exhibited in the

[3] It is indeed difficult for mere words to convey to the reader the minute details which an exhibit of the ball point pens themselves would make evident to the eye.

prior art. Further, the minutiae of these differing control methods are all based on such well known mechanical principles as that opposite projecting surfaces stop on contact, and the fact that a spring, when compressed, tends to expand when the compression is relieved.

Indeed, the only thing which Lovejoy even contends it adds to the art is the so-called "webbed portion," found in the lower end of its plunger. This is simply a slot in the plunger, which serves to anchor the spring latch, so that it may be nested in the plunger groove, and also tends to bias the spring latch laterally. But this lateral biasing of the spring latch was fully disclosed in the prior art, Lovejoy's device merely making use of the ancient principle of leverage, in the form of a cantilever, in supplying this lateral bias. Indeed, even this nesting principle has been used time out of mind in such common matter as a door latch. So the alleged addition of Lovejoy must have been obvious to a person of ordinary skill in the art.

Thus, since Scripto [Lovejoy] does not even contend that its patent adds anything to the essential characteristics of a ball point pen, and since its sole addition affects a very subordinate part of its mechanism, and by the use of principles which are either actually used in the prior art or are well known to one employed in such art, this patent clearly adds nothing to the fund of human knowledge, and is therefore not patentable. **Great A. & P. Tea Co. v. Supermarket Corp.**, 340 U. S. 147 (1950).

We now turn to the two Lovejoy design patents. Here again the crux is largely as to whether these patents are covered by the prior art. The statutory provisions in that regard are as follows:

> "Whoever invents any new, original and ornamental design for an article of manufacture, may obtain a patent therefore * * * The provisions of this Title

relating to patents for inventions shall apply to patents for designs * * *" 35 U. S. C. § 171.

"A patent may not be obtained, though the invention is not identically disclosed or described as set forth in Section 102 of this Title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious, at the time the invention was made, to a person having ordinary skill in the art which said subject matter pertains * * *" 35 U. S. C. § 103.

The leading case construing these provisions as to a design patent is **Palmer Co. v. Ludens, Inc.**, 236 F. 2d 496 (3 Cir 1956), where the court laid down the rule that:

"The specifications for the granting of a design patent, as set forth in the Act, are invention of a new, original and ornamental design, nonobvious to a person of ordinary skill in the art." p. 500.

The design must not only produce "a new and pleasing impression on the aesthetic sense" but "there must be an exercise of the inventive faculty, and if the design lacks this quality it will not suffice to say that it is new, original and ornamental and has received wide public acceptance." p. 500.

We turn to the first design patent, No. 171,093, the essence of which is claimed by Scripto to consist of the socalled sloping shoulders at the top of the barrel, with a similar slope on the cap of the plunger. However, these sloping shoulders have been known and used in writing instruments by the public for years. See **Furedy Design Patent 82,821**, issued December 16, 1930; **Morrison Design Patent 155,532**, issued October 11, 1949. Thus the essence of this patent is neither new nor original. With that design well known to the public, what could be more obvious

"to a person of ordinary skill in the art" of designing writing instruments, than to apply this same slope to the top of the barrel of the Lovejoy pen?

Of course, the fact that the top of the plunger cap of the Lovejoy pen had to project beyond this sloping barrel, for functional reasons, does not affect the fact that this slope in the barrel was old and well known. Granted, then, that this projection of the cap had to exist, what could be more obvious to the average designer in that field, than to have a slope in the top of the cap at the same angle as the slope in the top of the barrel? Hence this whole matter of the slope in the top of the Lovejoy pen appears to be neither new, nor original, nor nonobvious to a person of ordinary skill in the art. Whether it is ornamental is a matter of artistic taste, as to which one might well say "*de gustibus non disputandum.*" But, in any event, even if more ornamental than the straight, flat top, the difference in its aesthetic appearance is so slight that it would not seem to rise to the heights of invention anyway. For instance, if is by no means the equivalent of an ornamental caricature of a rabbit, or other animal, with exaggerated features, as compared with the normal realistic rabbit, or other animal, of natural proportions and postures. **Palmer Co. v. Ludens, Inc.**, supra.

As to the second design patent, this revolves substantially about the question of whether the change in the locale of the release button, from the barrel to the center of the clip, constitutes a patentable design. For similar reasons, this design would not appear patentable. That this changed locale for the release button is not "new" or "original" may be seen by a glance at **Bouhier's French Patent, No. 979,112**, issued December 6, 1950, whose release button is also located in the clip of its pen. That this change is truly "ornamental" is even less clear than are the sloping shoulders in the first Lovejoy design patent.

Of course, the extremely slight changes in the configuration of the button itself, and of the clip itself, are too minute and insubstantial to be called inventive. Thus the two Lovejoy design patents on which Scripto relies are also invalid.

Since the patents on which Scripto relies are invalid, so that it can make no lawful claim of infringement against Ferber, neither this matter of infringement, nor certain other issues raised by the parties, need be detailed.

The facts herein stated and the conclusions of law herein expressed shall be considered the findings of fact and conclusions of law required by F. R. C. P. 52.

An order may be entered accordingly, including an application to set down the unfair competition issues for trial.

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SCRIPTO, INC.,

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Supreme Court of the United States

OCTOBER TERM, 1959

No. 299

SCRIPTO, INC.,

Petitioner,

v.

FERBER CORPORATION,

Respondent.

Respondent's Brief in Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit

Introductory Statement

Respondent, Ferber Corporation, opposes the Petition for a Writ of Certiorari on the following grounds:

1—There is *not* here presented, any "real and embarrassing conflict of opinion and authority" (*Layne and Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393, 67 L. Ed. 712, 1923), or any other conflict, between the instant affirming decision of the Court of Appeals for the Third Circuit, and any decisions of the Court of Ap-

References used herein are: the letter "a", to petitioner's Appendix below; the letter "b", to respondent's Appendix below; "Pet.", to the instant Petition for Writ of Certiorari.

peals for the Seventh Circuit on the same matter. Petitioner's third paragraph under the heading "Jurisdiction" (Pet. p. 2) is a misstatement.

2—The uncontroverted facts are:

(a)—That the petitioner's three patents were held to be invalid by the Courts below, because they are all covered by the prior art;

(b)—That the record affords sound basis for said findings and conclusions;

(c)—That the Courts below did not, as asserted by petitioner, ignore the presumption of validity attaching to petitioner's patents or the statute expressing it; and

(d)—That there is no conflict between the Third Circuit's decision below and the decisions of the Seventh Circuit.

3—The purported questions posed by petitioner under the heading "Questions Presented" (Pet. p. 2), are not real or warranted. In urging that the Third Circuit differs from the Seventh Circuit concerning the effect of the patent examiner's failure to cite pertinent and relevant prior art, *petitioner has failed* to indicate to this Court:

(a)—That the Seventh Circuit cases relied on by petitioner as being in conflict, all concerned alleged prior art which was expressly found to be not anticipatory and not pertinent to a consideration of the validity of the patent in question and which the examiner might reasonably have concluded did not merit discussion or citation;

(b)—That in cases both preceding and following those relied on by petitioner, the Seventh Circuit has uniformly indicated its adherence to the rule *unanimously accepted*

by the Courts of Appeal of all Circuits which have considered the question, that the absence of citation or mention by the examiner of prior art which is so clearly pertinent and relevant that it ultimately leads the Court to conclude that it anticipated the patent in question, indicates that such prior art had not come to the attention of and was not considered by the examiner before his issuance of the patent, and consequently "weakens" or "detracts from the importance of" the presumption of validity of the patent;

(c)—That the decision in this case did *not* turn on the question now presented by petitioner, since both Courts below found that the evidence clearly demanded a conclusion of prior art anticipation, with consequent invalidity of the patents, and this regardless of the existence or weakening of the presumption of validity.

The issues tried before District Court Judge Hartshorne were limited to the validity, and alleged infringement by respondent Ferber Corporation (hereinafter "Ferber"), of 3 patents held by petitioner Scripto, Inc. (hereinafter "Scripto"), *viz.* #1—mechanical patent No. 2,748,748 (108a); #2—design patent No. 171,093 (89a); #3—design patent No. 176,469 (95a).

Judge Hartshorne's opinion found all 3 patents invalid because they "fail within the prior art" (Pet. p. 11); contained such findings as: "adds nothing to the fund of human knowledge" (Pet., p. 17); "neither new, nor original, nor non-obvious to a person of ordinary skill in the art" (Pet., p. 19); "difference * * * so slight * * * (as not) * * * to rise to the heights of invention" (Pet., p. 19); "not 'new' or 'original'" (Pet., p. 19); "slight changes * * * too minute and insubstantial to be called inventive" (Pet., p. 20); petitioner has made "* * * use of principles which are either actually used in the prior

art or are well known to one employed in such art, * * * " (Pet., p. 17).

The Court of Appeals for the Third Circuit upheld said conclusions of patent invalidity ("primarily because they are all covered by prior art"), by the district court, stating:

> "The record affords sound basis for these conclusions" (Pet., p. 11).

The evidence of relevant, anticipatory prior art patents presented at the trial and contained in said record below, was so clear and compelling as to necessarily overcome and vitiate the presumption of validity attaching to petitioner's patents by virtue of their issuance.

Petitioner does not contend and cannot show that the record fails to support the above quoted factual findings, nor can petitioner avoid their effect to deny patent validity under sections 102 and 103 of the Patent Act of 1952 (66 Stat. 797, 798, 35 U. S. C. 102, 103), which give the conditions for patentability as follows:

Section 102:

> "A person shall be entitled to a patent unless
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country * * *."

Section 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be pat-

ented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains * * *."

Concerning Petitioner's "Statement of the Case" (Pet., p. 3)

Petitioner's "Statement of the Case" repeats allegations (largely immaterial to its instant "Questions Presented"), submitted in its brief below, but which are still not supported by and indeed violate the record.

The issue of patent infringement was not decided, because petitioner's three patents were held invalid. Contrary to petitioner's assertions (Pet., p. 4), the record in the case amply shows that there are vital respects in which the Ferber mechanical construction and design and that "disclosed" in the Lovejoy patents in suit are different; that in the areas of identity in construction, both petitioner and respondent followed the prior art.

What Lovejoy claims to have taken him two and one-half years to develop, namely, a ball point pen "with easily replaceable ink supply which would be attractive and distinctive in design, economical to manufacture and assemble, and which would afford simple, foolproof operation in the hands of the public" (Pet., p. 3), was found by the Courts below to be covered by the prior art (Pet., pp. 11, 14).

On pages 4 to 7 of its petition, petitioner repeats almost parrot-like, bits of testimony and colloquy (out-of-context) which it unsuccessfully used in the Courts below. There are absolutely no facts or arguments printed in its petition which were not before the Court of Appeals. Fur-

thermore, there is nothing in its pages which rightfully belongs in a petition for writ of certiorari.

The petition on its face discloses that petitioner is attempting at this juncture to repeat and re-argue in this Court, under the guise of "questions presented", other contentions which have been expressly rejected by two Courts below.

ARGUMENT

POINT I

There is no conflict between the decision of the Third Circuit below, and the Seventh Circuit decisions relied on by petitioner.

Where evidence of pertinent and relevant prior art is presented to a court, it is *universally held* by *all* of the Courts of Appeal dealing with the matter, *including those of the Third and Seventh Circuits*, that the failure of the patent office to consider such pertinent prior art before issuing a patent in question weakens the presumption of validity which arises from such issuance.[1]

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[1] 1ST CIR.—*H. Schindler & Co., Inc.* v. *Saladino & Sons, Inc.*, 81 F. 2d 649 (1936); *Viash Refining Co., Inc.* v. *Azor, Inc.*, 158 F. Supp. 505 (D. R. I. 1957); *Robinson Aviation Inc.* v. *Barry Corp.* (D. Mass. 1952), 106 F. Supp. 514; 2ND CIR.—*Zoomar, Inc.* v. *Paillard Products, Inc.*, 258 Fed. 2d 527 (1958); *Gerald M. Friend, Inc.* v. *Walsh*, 141 F. 2d 180 (1944); *National Electric Products Corp.* v. *Grossman*, 70 F. 2d 257 (1934); *R. Hoe & Co.* v. *Goss Printing Press Co.*, 30 F. 2d 271 (1929); 3RD CIR.—*Dole Refrigerating Company* v. *Amerio Contact Plate Freezers, Inc.*, 265 F. 2d 627 (1959); *Messing* v. *Quiltmaster Corp.*, 162 F. Supp. 489 (D. N. J. 1958); *Selas Corp. of America* v. *Purolator Products, Inc.*, 159 F. Supp. 682 (D. N. J. 1958); *Slagboom* v. *Van Vlaanderen Machine Co.*, 139 F. Supp. 785 (D. N. J. 1956); *Osborn Mfg. Co.* v. *Newark Brush Co.*, 111 F. Supp. 846 (D. N. J. 1953); *Rock-Ola Mfg. Corp.* v. *Cusano*, 106 F. Supp. 723 (D. N. J. 1952); 4TH CIR.—*Gillette*

"We are not unmindful of the presumption of validity which attaches to the patent by virtue of its issuance, but that presumption cannot stand against *pertinent* art which was not considered by the Examiner."

Boynton v. *Chicago Hardware Foundry Co.*, 77 Fed. 2d 799, *7th Cir.*, 1935.

Where the patent Examiner fails to cite or refer to such relevant prior art, so clearly pertinent indeed that it leads the Court to conclude that it anticipated the patent in question, such non-citation is deemed by the Third and Seventh Circuits, and also by the other Circuits, to indi-

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Safety Razor Co. v. *Cliff Weil Cigar Co., Inc.*, 107 F. 2d 105 (1939); *Maibohm* v. *R. C. A. Victor Co.*, 89 F. 2d 317 (1937); *Specialty Equipment & Machinery Corp.* v. *Zell Motor Car Co.*, 113 F. Supp. 161 (D. Md. 1953); 5TH CIR.—*Fritz W. Glitch & Sons, Inc.* v. *Wyatt Metal & Boiler Works*, 224 F. 2d 331 (1955); *Rosaire* v. *Baroid Sales Division National Lead Co.*, 218 F. 2d 72 (1955), cert. den. 349 U. S. 916, 99 L. Ed. 1249; 6TH CIR.—*Royal Patent Corp.* v. *Monarch Tool & Mfg. Corp.* 203 F. 2d 299 (1953); *O'Leary* v. *Liggett Drug Company*, 150 F. 2d 656, 664 (1945), cert. den. 326 U. S. 773, 90 L. Ed. 467; *Western Auto Supply Co.* v. *American-National Co.*, 114 F. 2d 711 (1940); *Hamilton Laboratories, Inc.* v. *Massengrill*, 111 F. 2d 584 (1940), cert. den. 311 U. S. 688, 85 L. Ed. 444; *Lempco Products, Inc.* v. *Timken-Detroit Axle Company*, 110 F. 2d 307 (1940), cert. den. 311 U. S. 675, 85 L. Ed. 434; *France Mfg. Co.* v. *Jefferson Electric Co.*, 106 F. 2d 605 (1939), cert. den. 309 U. S. 657, 84 L. Ed. 1006 (1940); *Westinghouse Mfg. & Elec. Co.* v. *Toledo, P. C. & L. Ry. Co.*, 172 Fed. 371 (1909); 7TH CIR.—*Hobbs* v. *Wisconsin Power & Light Co.*, 250 F. 2d 100 (1957); *Nordell* v. *International Filter Co.*, 119 F. 2d 948 (1941); *Benjamin Electric Mfg. Co.* v. *Bright Light Reflector Co., Inc.*, 111 F. 2d 880 (1940); *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 F. 2d 937 (1938); *Moran* v. *Protective Equipment, Inc.*, 84 F. 2d 927 (1936); *Boynton* v. *Chicago Hardware Foundry Co.*, 77 F. 2d 799 (1935) 9TH CIR.—*Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, 266 F. 2d 613 (1959); *Jacuzzi Brothers, Inc.* v. *Berkeley Pump Co.*, 191 F. 2d 632 (1951); *Gomez* v. *Granat Bros.*, 177 F. 2d 266 (1949), cert. den., 338 U. S. 937, 94 L. Ed. 578 (1950).

cate that such pertinent prior art was not considered by the Examiner before he issued the patent. (*American Soda Fountain Co.* v. *Sample*, 130 Fed. 145, at 149, 150, (3rd Cir. 1904), cert. den. 195 U. S. 634, 49 L. Ed. 354, (1904). See also the other cases cited *supra, e.g. Johnson Laboratories* v. *Meissner Mfg. Co.*, 98 Fed. 2d 937, (7th Cir. 1938); *Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, 266 F. 2d 613, (9th Cir. 1959); *O'Leary* v. *Liggett Drug Co.*, 150 F. 2d 656, (6th Cir. 1945); *Gerald M. Friend, Inc.* v. *Walsh*, 141 F. 2d 180 (2nd Cir. 1944); *Gillette Safety Razor Co.* v. *Cliff Weil Cigar Co., Inc.*, 107 F. 2d 105, (4th Cir. 1939); *Schindler & Co., Inc.* v. *Saladino etc. Inc.*, 81 Fed. 2d 649, (1st Cir. 1936).)

> "The file wrapper shows that the Patent Office in considering the * * * patent cited none of the prior art that is here relied upon; that of the * * * (other) patent (in question) discloses no citation of prior art. Consequently the presumption of validity of either patent is greatly weakened. It cannot stand against pertinent art which was not considered by the examiner".
>
> *Johnson Laboratories* v. *Meissner Mfg. Co., supra,* at p. 943, *C. C. A. 7th.*
>
> "* * * (We) think the force of that presumption (of validity) is much diminished if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the * * * (specified prior art) patents. *It does not seem likely that an expert examiner would pass them by without notice or consideration, if they had been called to his attention*".
>
> *American Soda Fountain Co.* v. *Sample, supra,* at pp. 149, 150, *C. C. A. 3rd.*

The foregoing was the situation presented by the record below. None of the seven pertinent prior art patents listed by the Trial Judge in his "Note 2" (Pet. p. 13), which were relevant on the validity of petitioner's mechanical patent, was cited or referred to by the patent examiner; and the same was true as to the two design patents (Pet. p. 13). In view thereof and in accordance with the universally accepted proposition above set out, the Courts below indicated that the importance of the presumption was lessened (Pet. pp. 11, 13).

Like the Third Circuit, the Seventh Circuit is in accord with the foregoing accepted proposition.

The Seventh Circuit so held in cases *preceding* those cited by petitioner. (*Johnson Laboratories* v. *Meissner Mfg. Co.*, quoted *supra*; *Boynton* v. *Chicago Hardware Foundry Co.*, quoted *supra*; *See also*; *Moran* v. *Protective Equipment, Inc.*, 84 Fed. 2d 927, at 943, C. C. A. 7th, 1936; *Benjamin Electric Mfg. Co.* v. *Bright Light Reflector Co.*, 111 F. 2d 880, C. C. A. 7th 1940; *Nordell* v. *International Filter Co.*, 119 F. 2d 948, C. C. A. 7th 1941).

The Seventh Circuit also so held, 2 years *after* the latest of the cases relied on by petitioner (*Hobbs* v. *Wisconsin Power & Light Co.*, 250 Fed. 2d 100 at 105, *C. C. A. 7th*, 1957).

Nor do the *Artmore* and other Seventh Circuit cases relied on by petitioner (Pet. pp. 8, 9) for the alleged "conflict", say or indicate that the Seventh Circuit does not adhere to the aforementioned proposition which it had already accepted and continued thereafter to accept, in the cases just cited.

In contrast to the situation in which the non-cited prior art was pertinent and relevant and indeed, found by the Court to be anticipatory, is that in which the non-cited

prior art relied on was not pertinent or relevant and did not anticipate.

In that latter situation, where the non-cited prior art urged on the Court is clearly non-pertinent, the mere fact that the examiner did not cite same, does not necessarily indicate that he failed to consider it. Since it is not pertinent, it seems as reasonable to conclude that it was not cited for that reason, as to assume that the examiner overlooked it. Such is the holding of the *Artmore* and other Seventh Circuit cases relied on by petitioner, in each of which the prior art claimed to be anticipatory was expressly held to be not pertinent and non-anticipatory.

The question of what conclusion is to be drawn from the Patent Office's non-citation of prior art, is of course a matter of logical inference. The conclusion will naturally vary depending upon how likely it is that the examiner would have considered the prior art and then discarded it without citation. When the prior art is clearly irrelevant, it is quite likely that the examiner will not trouble to cite it, and the Seventh Circuit accordingly so stated in those cases relied on by petitioner. But when the non-cited prior art is plainly relevant and pertinent—so pertinent, in fact, that it ultimately leads a court to conclude that it anticipated the patent in question—it is wholly unreasonable to assume that the examiner would discard it without citation. This too, the Seventh Circuit Court has held, as has every other circuit court, and it is simply this that the courts below said in the instant case. The two results are not conflicting. They are different sides of the same coin, and in fact, complement each other.

Assuming *arguendo* (although not true) that there is a conflict between the language of those Seventh Circuit cases cited by petitioner, and that of the Third Circuit in the instant case, there is still not that "real and

embarrassing conflict of opinion between the Circuit Courts of Appeal" which should lead this Court to grant certiorari. As noted above, there are several Seventh Circuit cases preceding those cited by petitioner which adhere to the unanimous rule quoted by the Third Circuit in this case. And the most recent statement of the Seventh Circuit on this point (*Hobbs* v. *Wisconsin Power & Light Co., supra*), reaffirms (if such reaffirmation were needed) its position in accord with the position of the Third Circuit and of all of the other circuits which have passed on the question.

POINT II

The decision below did not turn on the questions posed by petitioner herein; rested on factual findings of prior art anticipation, compelling a determination of invalidity.

It is, of course, clear that the presumption of validity of a patent does not bar or prohibit the presentation of evidence showing it to be invalid. The statute says only,

> "The burden of establishing invalidity of a patent shall rest on a party asserting it" (66 Stat. 812, 35 U. S. C. 282; Pet., p. 3).

It is settled that said presumption of validity attaching by the mere issuance of a patent is rebuttable. (*Radio Corp. of America* v. *Radio Engineering Laboratories, Inc.*, 293 U. S. 1, at 8, 79 L. Ed. 163, at 168, 1934; *Westinghouse Electric & Mfg. Co.* v. *Formica Insulation Co.*, 266 U. S. 342, at 348, 69 L. Ed. 316, at 321, 1924; *Steffon* v. *Weber Heating and Sheet Metal Co.*, 237 F. 2d 601, 8th Cir. 1956; *United States Air Conditioning Corp.* v. *Governair Corp.*, 216 F. 2d 430, 10th Cir. 1954).

It is also settled that, while one who asserts a patent's invalidity because of prior art anticipation has the burden of establishing that proposition (36 U. S. C. A. Sec. 282), once the evidence has established such anticipation, the patent must be held invalid (*Rothe* v. *Ford Motor Co.*, 253 F. 2d 353, 355, D. C. Cir., 1958, *Crosley Corp.* v. *Westinghouse Electric & Mfg. Co.*, 152 F. 2d 895, 904, 3d Cir. 1945); and this, even where the patent office had considered such prior art. (*Crosley Corp.* v. *Westinghouse Electric & Mfg. Co., supra; Huston* v. *Buckeye Bait Corp.*, 145 F. Supp. 600, 604-05, S. D. Ohio 1955, aff'd 237 F. 2d 920, 6 Cir. 1956. See, *Lewyt Corp.* v. *Healthmor, Inc.*, 181 F. 2d 855, at 857, 7 Cir., 1950, cert. den., 340 U. S. 823, 95 L. Ed. 605, 1950).

The evidence of the pertinent prior art here presented to the District Court was so complete and compelling, and so clearly established prior art anticipation, that the Courts below were compelled to hold the patents invalid; no rebuttable presumption of validity could sustain the patents in suit in the face of that evidence.

This Court is not interested in reweighing that evidence, and we shall not needlessly burden it with a discussion thereof. A few citations from the opinions below make clear the grounds for the decision, and show beyond doubt that it turned on the compelling weight of the evidence of prior art anticipation and lack of invention, not on any unsettled principle of law demanding this Court's attention.

Thus, as to petitioner's mechanical patent, the Trial Judge found that:

> "An inspection of all this prior art shows that the major additions to human knowledge which were made by the invention of the ball point pen were each and all well known to the public through

this prior art before Lovejoy applied for a single one of his patents * * *. Every single one of these essential characteristics of the ball point pen, as used under the Lovejoy patents by Scripto, * * * is essentially the same as that shown in one or the other of the patents which comprise this prior art; * * *". (Pet., p. 14.)

"Indeed, the only thing which Lovejoy even contends it adds to the art * * * was fully disclosed in the prior art, Lovejoy's device merely making use of the ancient principle of leverage, * * *. So the alleged addition of Lovejoy must have been obvious to a person of ordinary skill in the art." (Pet. pp. 16, 17.)

"* * * since Scripto (Lovejoy) does not even contend that its patent adds anything to the essential characteristics of a ball point pen, and since its sole addition affects a very subordinate part of its mechanism, and by the use of principles which are either actually used in the prior art or are well known to one employed in such art, this patent *clearly* adds nothing to the fund of human knowledge, adn is therefore not patentable." (Pet. p. 17.)

As to petitioner's design patent No. 171,093, evidence of "prior art" patents issued to Furedy, Morrison, Spatz, Kahn, Thull, Biro and Lipic, was introduced, showing slopes or tapers substantially identical with those in petitioner's design. Petitioner's discussion at pages 5 to 7 of its petition, comprises incomplete and out-of-context references, and fails to note that the Trial Judge, after having heard all the evidence and after analyzing the prior art, found that "these sloping shoulders have been known and used in writing instruments by the public for years * * *. Thus the essence of this patent is neither

new nor original * * * nor nonobvious to a person of ordinary skill in the art" (Pet., pp. 18, 19).

As to design patent No. 176,469, plaintiff's attorney admitted at the trial that plaintiff's claim of alleged novelty in this design, lies solely in the incorporation of the release button in the clip (76b; 77b). Evidence of "prior art" patents to Bouhier, Kimberly and Rosa was presented, all showing prior use of release buttons located in the clip. (As to the Bouhier patent, petitioner cites the obscurity of the patent drawing reproduction in evidence (Pet., p. 7); fails to advise this Court that petitioner's attorney finally conceded in open court that the release button "goes through the clip" (102b).) The Trial Judge accordingly found petitioner's claim *not* "new" or "original", but fully covered in the prior art (Pet., pp. 19, 20).

Thus, the uncontradicted evidence of anticipatory prior art, which clearly negatived any inventive features of the claims of the patents in suit, compelled the factual findings of invalidity of the courts below.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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